

Rejection under 35 U.S.C. § 101

Examiner has rejected claims 9 through 14 under 35 U.S.C. § 101, asserting that the claimed invention lacks patentable utility. Applicant traverses the rejection and respectfully requests reconsideration.

As interpreted by the Federal courts, 35 U.S.C. § 101 has two purposes. First, 35 U.S.C. 101 defines which categories of inventions are eligible for patent protection. Second, 35 U.S.C. § 101 serves to ensure that patents are granted on only those inventions that are “useful”. Thus to satisfy the requirements of 35 U.S.C. § 101, an applicant must claim an invention that is statutory subject matter and must show that the claimed invention is “useful” for some purpose either explicitly or implicitly. See MPEP 2107.01.

Claims 9 through 14 satisfy both these criteria.

Specifically, claims 9 through 14 are directed to “an electronic mail system”. An electronic mail system is clearly a machine patentable under 35 U.S.C. 101. Therefore, claims 9 through 14 clearly satisfy the first criterion of 35 U.S.C. § 101.

Second, as shown by the Specification at page 2, lines 3 through 6, the invention set out in claims 9 through 14 is particularly useful for allowing one or more addresses to be removed from a group list in an address field. The addresses to be removed can be specified individually and/or as part of a group

list placed in one of the special fields. Therefore, claims 9 through 14 clearly satisfy the second criterion of 35 U.S.C. § 101.

It is clear, therefore, that claims 9 through 14 set out subject matter patentable under 35 U.S.C. § 101.

In Examiner's explanation for the rejection, Examiner appears to be considering only the elements of the claims, and not each of the claims as a whole. When determining whether a claim fulfils the requirements of 35 U.S.C. § 101, it is not sufficient to evaluate the elements of the claim separately. Rather, when determining whether a claim fulfils the requirements of 35 U.S.C. § 101 it is necessary to consider the claim as a whole, including the preamble and all the elements. When claims 9 through 14 are each considered as a whole, including the preamble and all the elements, it is clear that these claims satisfy both criteria for patentability under 35 U.S.C. 101.

Rejection under 35 U.S.C. § 102 (b)

Examiner has rejected claims 1 through 14 under 35 U.S.C. § 102 (b) as being anticipated by what Examiner has called Microsoft Corporation's MICROSOFT OUTLOOK 2000, hereinafter Outlook. Applicant respectfully traverses the rejection and requests reconsideration.

Criteria for a Rejection under 35 U.S.C. § 102(b)

35 U.S.C. § 102 (b) states that a person shall be entitled to a patent unless "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

Examiner has failed to cite art that qualifies as prior art under 35 U.S.C. § 102 (b).

Discussion of Prior art cited by Examiner

Examiner has rejected claims 1 through 14 under 35 U.S.C. § 102 (b) as being anticipated by Outlook.

Applicant's copy of Outlook is poor, with much of the dark sections being completely blacked out. However, enough of Outlook is decipherable to make clear that Outlook does not qualify as prior art under 35 U.S.C. § 102 (b).

Outlook, as cited by Examiner includes three Figures. According to Examiner, Figure 1 includes copyright and publication dates for Microsoft Corporation's software program MICROSOFT OUTLOOK 2000. Applicant is relying on Examiner's description of this Figure as the print on Figure 1 is unreadable in the copy received by Applicant.

From the readable parts of Figure 2, it looks like Examiner has printed a screen shot of an untitled e-mail message that Examiner has prepared. It looks like the e-mail message is variously addressed to Roswell, Michael; 2173

Examiners; Detwiler, Brian; 2174 Examiners; Bonshock, Dennis; 2179 Examiners and Cabeca, John. In the part of the e-mail message where the message text normally is placed, Examiner has apparently typed the phrase: "Do not send to: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler".

From the readable parts of Figure 3, it looks like Examiner has printed a screen shot of the same untitled e-mail message shown in Figure 2, with some minor modifications. Specifically, it looks like Examiner has removed some of addresses from the untitled e-mail message shown in Figure 2. Specifically, Examiner has removed the names: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler.

In order for Figures 2 and 3 of Outlook to qualify as prior art under 35 U.S.C. § 102 (b), it would be necessary for Examiner to show that Figures 2 and 3 of Outlook were in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States. However, it is clear that Figures 2 and 3 are very recent creations by Examiner and were not published before July 26, 2000. Therefore, Figures 2 and 3 of Outlook are not available as prior art for purposes of evaluating the claims of the present case under 35 U.S.C. § 102(b).

Applicant notes that it should be possible in light of the teaching in Applicant's Specification, to modify Microsoft Corporation's software program MICROSOFT OUTLOOK 2000 in a way to fall within the subject matter set out in the claims of the present case. However, such a modification or use of Microsoft

Corporation's software program MICROSOFT OUTLOOK 2000 to, in hindsight from Applicant's Specification, recreate the subject matter set out in the claims of the present case only serves to show that Applicant has satisfied the requirement of first paragraph of 35 U.S.C. § 112 that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

Examiner's ability to modify or use Microsoft Corporation's software program MICROSOFT OUTLOOK 2000, in hindsight from Applicant's teaching, to reproduce the subject of the claims of the present case does not demonstrate that the subject matter of the claims is anticipated. For anticipation under 35 U.S.C. § 102 (b), Examiner must show that such a modification occurred before July 26, 2000.

Conclusion

Applicant believes the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
PHYLLIS A. ELLENDMAN

By Douglas L. Weller
Douglas L. Weller
Reg. No. 30,506

March 8, 2005
Santa Clara, California
(408) 985-0642